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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,639	05/16/2006	Peter Tunguy-Desmarais	5288-0102PUS1	8755
2292 7590 11/20/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER KARPINSKI, LUKE E				
ART UNIT		PAPER NUMBER		
1616				
NOTIFICATION DATE		DELIVERY MODE		
11/20/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/562,639

Applicant(s)

TUNGUY-DESMARAIS, PETER

Examiner

LUKE E. KARPINSKI

Art Unit

1616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/2009 has been entered.

Claims

Claims 6, 8, and 9 are canceled.

Claims 1, 2, 5, and 7 are amended.

Claims 10-15 are new.

Claims 1-5, 7, and 10-15 are pending and under consideration in this action.

Rejections

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

New Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-5, 7, and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,073,937 to Van Cleave in view of US Patent 6,387,382 to Saleh et al.

Applicant Claims

Applicant claims a composition consisting of a water repellant agent and an antimicrobial agent, specifically the essential oil of melaleuca alternifolia.

Applicant also claims a method of treating ear disorders consisting of applying said composition to the external ear canal, said water repellent agent as a silicone polymer, specifically a polysiloxane, and percentages for said components.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Van Cleave teaches the application of a composition to the external ear canal for treatment of water related ear disorders (abstract and drawings) consisting of a surface tension reducing agent (abstract and claim 1) and that said compositions may also comprise bactericidal agents (col. 4, lines 21-29) as pertaining to claims 1-3.

Van Cleave further teaches that said surface tension reducing agents must be non-ionic and substantially water insoluble and provide a coat along the external ear canal for an average period of swimming (col. 4) as pertaining to claims 1, 2, 3, and 4, and that said compositions consist of said surface tension reducing agent, which reads as 100% of said composition (claim 1).

Ascertainment of the Difference between Scope the Prior Art and the Claims (MPEP §2141.012)

Van Cleave does not teach said surface tension reducing agent as a polysiloxane. This deficiency in Van Cleave is cured by Saleh et al. Saleh et al. teach water-proof skin barrier compositions comprising polysiloxanes as film forming agents with water repellency properties (col. 1, lines 63-67 and col. 4, lines 19-21).

Further, Van Cleave does not teach tea tree oil (*melaleuca alternifolia*) as claimed in claims 1 and 2. This deficiency is cured by Saleh et al. Saleh et al. teach said film forming compositions comprising antibacterial agents, specifically tea tree oil (*melaleuca alternifolia*), present from 0.001-4% (col. 7, lines 55-63).

Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)

Regarding claims 1 and 2, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the compositions of Van Cleave with a bactericidal agent in order to produce the invention of instant claims 1 and 2.

One of ordinary skill in the art would have been motivated to do this because Van Cleave teaches that said surface tension reducing compositions may contain bactericidal agents. Therefore it would have been obvious to utilize a bactericidal agent in the compositions of Van Cleave.

Regarding claims 1 and 2, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the compositions of Van Cleave with a polysiloxane as said surface tension reducing agent as taught by Saleh et al. in order to produce the invention of instant claims 1 and 2.

One of ordinary skill in the art would have been motivated to do this because Van Cleave teaches surface tension reducing agents for application to the skin, wherein said agents are non-ionic and form a film and Saleh et al. teach compositions for forming

films on the skin comprising polysiloxanes as said agents, said polysiloxanes being non-ionic and capable of forming a film on the skin and also known as surface tension reducing agents. Therefore it would have been obvious to utilize the polysiloxanes of Saleh et al, with the compositions of Van Cleave in order to produce said formulations with other known surface tension reducing agents safe for topical application to the skin.

Regarding claims 1 and 2, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to produce the formulations of Van Cleave with tea tree oil as taught by Saleh et al. in order to produce the invention of instant claims 1 and 2.

One of ordinary skill in the art would have been motivated to do this because Van Cleave teaches compositions which may contain a bactericide and Saleh et al. teach similar composition which comprise tea tree oil as an antibacterial. Therefore it would have been obvious to utilize the tea tree oil of Saleh et al., with the compositions of Van Cleave in order to produce a composition with a known antibacterial for topical film forming compositions.

Regarding the percentage limitations Van Cleave teach compositions consisting of surface tension reducing agent, which reads on 100%, said compositions optionally containing a bactericide and Saleh et al. teach similar skin coating compositions comprising 0.001-4% tea tree oil. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to add 0.001 to 4% tea tree oil to the composition of Van Cleave consisting of 100% surface tension reducing agent, thereby altering said percentage to 99.999-96%.

Regarding claim 5, said tea tree oil would necessarily act against bacterial and fungal infections as it is an anti-bacterial agent.

Regarding the limitations of said compositions capable of being applied with a dropper, said compositions are in liquid form and inherently capable of being applied with a dropper, further, Van Cleave teaches said formulations being applied in drop form

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Claims 1-5, 7, and 10-15 are rejected.

No claims are allowed.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Friday 9-5 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/
Primary Examiner, Art Unit 1616